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10/686,037	10/15/2003	Erich Kast	BE-119	4999

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EXAMINER

COMSTOCK, DAVID C

ART UNIT	PAPER NUMBER
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3733

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/686,037
Filing Date: October 15, 2003
Appellant(s): KAST ET AL.

MAILED
MAY 03 2006
Group 3700

Friedrich Kueffner
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 20 January 2006 appealing from the Office action mailed 23 March 2005.

(1) Real Party in Interest

The statement of the real party in interest contained in the brief is correct.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement regarding the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Bernard et al. (FR 2 795 945 A1; *cf. corresponding* US 6,964,687 B1 and US 2005/0125029 A1).

(9) Grounds of Rejection

Examiner's grounds of rejection to be reviewed on appeal are contained in the final Office action mailed on 23 March 2005, at page 2.

(10) Response to Argument

Examiner's position and Response to Arguments are contained in the final Office action mailed on 23 March 2005 (see page 4, line 11 - page 5, line 2). It is again noted that if the structure of the implant of Bernard et al. is at least capable of performing the intended use of appellant's implant, as set forth in appellant's claims, then it meets the limitations of the claims. Thus, if the implant of Bernard et al. is at least capable of being turned around (i.e. 180°) before being inserted between adjacent vertebrae, then

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it meets the claims, and the rejection under 35 USC 102(b) should be maintained. Of course, capability is not the same as what might be optimal or preferred. Obviously, the implant of Bernard et al. is intended to be inserted with a tool that engages the seats 20, 23, such that the maximum height of the implant would be in the first third of the implant rather than the last third, as viewed from the front of a vertebral column. However, this intended manner of use is not the only manner of use. For example, the implant is clearly at least capable of being grasped on any portion thereof with forceps and of being inserted into a vertebral space in any desired orientation.

Appellant's arguments clearly depend on the intended orientation of the device (e.g., with respect to the chest and the back). For example, see appellant's statement, beginning at page 6, line 13 of the brief:

"However, even if the maximum [height, sic] of the implant described by Bernard et al. were to be located in the last third *facing the chest*, and *this implant would then have structural features similar to those of the implant according to the present invention*, the reference does not disclose and cannot render obvious the present invention as claimed. The structural features of such implants can under no circumstances be taken into consideration separately from the *intended implant location*. The structural features of the implant described by Bernard et al. clearly do not display the technical teaching of the present invention which resides in that the maximum of the implant height is to be located in the last third which *fascies [sic] the back*." (examiner's emphasis)

In conclusion, it is believed that the structure and capability of the implant of Bernard et al. satisfy the claims.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this Examiner's Answer.

For the above reasons, it is believed that the rejections should be maintained.

Respectfully submitted,

DC



20 April 2006

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